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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,851	07/24/2003	Toshiyuki Hosokawa	107348-00358	8943
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ARENT FOX LLP				
1050 CONNECTICUT AVENUE, N.W.				
SUITE 400				
WASHINGTON, DC 20036				
EXAMINER				
NGUYEN, DONGHAID				
ART UNIT		PAPER NUMBER		
3729				
NOTIFICATION DATE		DELIVERY MODE		
04/14/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com

IPMatters@arentfox.com

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Office Action Summary

Application No.

10/625,851

Applicant(s)

HOSOKAWA, TOSHIYUKI

Examiner

DONGHAI D. NGUYEN

Art Unit

3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2009.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-9 is/are pending in the application.
4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 2 and 4-7 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed on February 3, 2009 has been considered and made of record.

Election/Restrictions

2. Newly submitted claims 8 and 9 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Inventions of original claims 1, 2, 4-7 and of newly submitted claims 8-9 are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because original claims 1, 2 and 4-7 do not require using the plurality of part to fix the cable to the structure of the newly submitted claims. The subcombination has separate utility such as fixing the cable to the structure.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable

in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 8 and 9 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,781,990 to Seidler et al. in view of Inoue et al.

Regarding claim 1, Seidler et al disclose a process for mounting a plurality of parts (23-25) to a cable comprising: feeding the cable (2) into a cable-cutting and imprinting machine (1, see Fig. 1); marking (by print jet 17) the cable (2) with information for mounting each of the parts on the cable (see Fig. 3), the cable being a single unbroken member (see Fig. 1), the information including mounted positions of each of the parts on the cable (see Col. 6, lines 18-23), the mounted positions of each of the parts being intermediate between opposite longitudinal ends of the cable in a state where the cable is used (see Col. 9, lines 1-7); and mounting each of the parts on the cable at a corresponding mounted position marked on the cable (see Figs. 4).

Seidler partially cut the cable to a predetermined length when the cable fed into the cable-cutting and imprinting machine reaches the predetermined length, but do not completely cut. Inoue et al teach cutting the cable to a predetermined length when the cable fed into the cable-cutting and imprinting machine reaches the predetermined length, by the cable-cutting and imprinting machine (see Fig. 4) and thereafter mounting parts to cable (see Col. 5, lines 35-43) for improving cable installation methods (see Col. 6 lines 64-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Seidler et al by utilized cutting and mounting methods as taught by Inoue et al. for improving methods of fixing the mounting parts to the cable.

Regarding claim 2, Seidler et al disclose marking the cable with information for mounting each of the parts including a name and a mounted attitude of each of the parts (see Col. 6, lines 18-23).

Regarding claims 6 and 7, Seidler et al disclose the cable is a sensor harness for a device, an antilock brake (see col. 9, line 53-56), mounted on a vehicle (see Col. 8, lines 13-14).

5. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seidler/Inoue et al. as applied above in view of US Patent 6,267,385 to Okamoto et al.

Seidler/Inoue et al. as applied and relied above is silent regarding how the plurality of parts being mounted onto the cable. Okamoto et al teach the step of mounting the plurality of parts to the cable by sliding mounting parts (10) onto the cable 14 and fixing the mounting part (10) to the cable by the adhesive (12) for easily fixing the mounting parts to the cable (see Col. 3, lines 9- 12). Therefore, it would have been obvious to one having ordinary skill in the art at the

time the invention was made to modify the invention of Seidler/Inoue et al. by utilized the mounting method as taught by Okamoto above for easily fixing the mounting parts to the cable.

Response to Arguments

6. Applicant's arguments with respect to claims 1, 2 and 4-7 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DONGHAI D. NGUYEN whose telephone number is (571)272-4566. The examiner can normally be reached on Monday-Friday (9:00-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H. Banks can be reached on (571)-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DN
April 7, 2009

/Donghai D. Nguyen/
Primary Examiner, Art Unit 3729